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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,802	11/03/2003	Thomas Poslinski	81099/7114	6271

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EXAMINER	
SHIBRU, HELEN	
ART UNIT	**PAPER NUMBER**
2621	
MAIL DATE	**DELIVERY MODE**
01/02/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/700,802	POSLINSKI ET AL.	
	Examiner	Art Unit	
	HELEN SHIBRU	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2007 has been entered.

Response to Amendment

2. The amendments, filed 10/31/2007 have been entered and made of record. Claims 1-16 are pending.

Response to Arguments

3. Applicant's arguments filed 10/31/2007 have been fully considered but they are not persuasive.

In re page 5 Applicant states " The office action stated that Okada taught the use of a free memory list....the memory space in Okada is directly freed and reallocated 'on the fly' without the use of any type of memory list."

The Examiner respectfully disagrees on this argument. First of all, the rejection was made based on 35 U.S.C. 103(a) and the Examiner stated that Okada fails to teach storing in a memory a free memory list. Second, it is noted that the features upon which applicant relies (i.e., the **use** of memory list or using memory list) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The

claim only recite adding portion to the free memory list and storing a free memory list. In addition Okada discloses VOBU#1 and VOBU#2 are lists of free memory after deletion, i.e. blocks VOBU#! And VOBU#2 are added to the lists after deletion of portions of VOB.

In response to applicant's arguments against the references individually (in re page 5 Applicant states there is no teaching or suggestion in Hoang as to selecting a portion of a file and adding that portion to the free memory list as recited in claim 1), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In re page 6 Applicant states "The office action stated that Okada taught the use of starting and ending flags."

In response the Examiner respectfully disagrees. The office action does not state "Okada taught the use of starting and ending flags." The Examiner respectfully request Applicant to show the portion of the Office Action where it states this limitation. The Examiner rejected claim 8 under 35 U.S.C 103(a) combining with the prior art of Ahn which discloses the starting flag

indicating a starting point located *anywhere* in the media and ending flag indicating an ending point located *anywhere* in the media.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., in re page 6-7 Applicant states "As for Ahn... the START flag indicates whether data that includes a start code has been detected.") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The claimed invention does in fact read on the cited references for at least the reasons discussed above and as stated in the detail Office Action as follows.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (US Pat. No. 2004/0264947A1) in view of Hoang (US PG PUB 2003/0126201 A1).

Regarding claim 1, Okada discloses a method of increasing the available storage space on an electronic storage medium comprising the steps of: providing a free memory list for the electronic storage medium (see paragraphs 0367 and 0373 where portion selected to be deleted); selecting a portion of a file stored on the electronic storage medium (see paragraphs 0373 and

0308, portion of the file deleted); and adding the selected portion of the file to the free memory list (see paragraphs 0223 space is freed after deletion).

Claim 1 differs from Okada in that the claim further requires storing in a memory a free memory list the free memory list identifying at least one free portion of memory.

In the same field of endeavor Hoang discloses storing free memory block list in a memory (see paragraphs 0039-0041 and claim 13). Therefore in light of the teaching in Hoang it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okada by storing free memory list in a memory in order to store and reflect updates.

Regarding claims 2 and 5, Okada discloses the file is an audio file or a video file (see fig. 74).

Regarding claim 3, Okada discloses the selecting the portion of the file stored on the electronic storage medium creates a plurality of file segments (see figs 7A-D, 15A-C, and 74).

Regarding claim 4, Okada discloses the step of linking the plurality of file segments together (see paragraphs 0853-0863).

Regarding claims 6 and 7, Okada discloses the electronic storage medium is a memory of a personal video recorder (see fig. 16 and paragraph 0222).

6. Claims 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Ahn (US Pat. No. 6,233,695).

Regarding claim 8, Okada discloses a method of increasing the available storage space on a personal video recorder comprising the steps of: storing a media file on a memory of the personal video recorder (see paragraphs 0222, 0378, 0379 and fig. 16); receiving a signal for marking a starting flag for the media file (see paragraphs 0367 and 0373); receiving a signal for

marking an ending flag for the media file (see paragraph 0367); and freeing the memory of the personal video recorder that contains a portion of the media file between the starting flag and the ending flag (see paragraphs 0222, 0713, and figs. 6A-B).

Claim 8 differs from Okada in that the claim further requires the starting flag indicating a starting point located anywhere in the media and ending flag indicating an ending point located anywhere in the media.

In the same field of endeavor Ahn discloses the starting flag indicating a starting point located anywhere in the media and ending flag indicating an ending point located anywhere in the media (see col. 3 line 40-col. 4 line 14). Therefore in light of the teaching in Ahn it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Okada by providing an ending and starting flag in the media in order specify the exact location.

Regarding claim 9, Okada discloses the freeing of the memory of the personal video recorder comprises deleting the portion of the media file between the starting flag and the ending flag (see paragraphs 0367, 0373 and 0708).

Regarding claim 10, Okada discloses the freeing of the memory of the personal video recorder comprises deallocating the memory of the personal video recorder containing the portion of the media file between the starting flag and the ending flag (see paragraph 0366 and 0372).

Regarding claim 11, Okada discloses the marking of the start flag comprises marking a first presentation time stamp and wherein the marking of the end flag comprises marking a

second presentation time stamp (see paragraph 0368, see also abstract, fig. 5 and col. 3 lines 40-50 in Ahn).

Regarding claim 12, Okada discloses a first full frame image with the first presentation time stamp (see figs 7A-D and paragraphs 0238 and 0246); associating a second full frame image with the second presentation time stamp (see paragraphs 0238 and 0246).

Regarding claim 13, Okada discloses a method of increasing the available storage space on a personal video recorder comprising the steps of: searching for a start program time stamp marking a video file (see paragraphs 0030 and 0878); searching for a first full image frame related to the start program time stamp (see paragraphs 0030 and 0879); searching for an end program time stamp marking the video file (see paragraphs 0030 and 0880); searching for a second full image frame related to the end program time stamp (see paragraphs 0880, 0882 and figs 47A-B); and deleting a portion of the video file between the first full image frame and the second full image frame (see paragraphs 0881 and figs. 71-73).

Claim 13 differs from Okada in that the claim further requires the starting flag indicating a starting point located anywhere in the media and ending flag indicating an ending point located anywhere in the media.

In the same field of endeavor Ahn discloses the starting flag indicating a starting point located anywhere in the media and ending flag indicating an ending point located anywhere in the media (see col. 3 line 40-col. 4 line 14. PTS in a sector contains end and start point of frame. Start time and end time information are time information obtained from PTS in MPEG system). Therefore in light of the teaching in Ahn it would have been obvious to one of ordinary skill in

the art at the time the invention was made to modify Okada by providing an ending and starting flag in the media in order specify the exact location.

Regarding claim 14, Okada discloses the step of deleting a portion of the video file creates a plurality of video segments (see fig. 74).

Regarding claim 15, Okada discloses combining the plurality of video segments into a second video file (see paragraphs 0882-0886).

Regarding claim 16, Okada discloses the deleting comprises removing at least a portion of a commercial within the video file (see paragraph 0222).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Helen Shibru
December 18, 2007